

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airmail No. Box #1 - EM 057522105 US, Box #2 - EM 057522199 US, Box #3 - EM 057522208 US, Box #4 - EM 057522211 US, on the date shown below in four boxes addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 14, 2007

Signature: 

(Anthony Matson)

Patent

Docket No. 532212000624

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER MPEP § 724.02

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the documents listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to these documents because they are **SUBJECT TO PROTECTIVE ORDER** or **PROPRIETARY** information. It is respectfully requested that the Examiner consider the information during the prosecution of this application.

The document numbers 1-84 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is

sd-384193

EXHIBIT A

Serial No. 10/760,091

enclosed in a sealed, clearly labeled envelope. Document numbers 1-75 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), appealed at the United States Court of Appeals for the Federal Circuit as case numbers 06-1087 and 06-1443. Document numbers 76-84 are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx). Scantibodies Laboratory, Inc. is the assignee of the present application.

Document number 85 listed on the attached Form PTO/SB/08a/b is **PROPRIETARY** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of the **PROPRIETARY** document listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

Pursuant to MPEP § 2004.13, Applicants point out the following:

- Exhibit M of document No. 3, "Claim Chart for U.S. Patent No. 6,030,790" submitted by Nichols, in which United States Patent number 6,689,566 (the '566 patent) is discussed. The present application is a Continuation of United States Patent number 6,743,590, which is a Continuation-in-Part of the '566 patent.
- Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D. (Document No. 13 in the present Form PTO/SB/08a/b), in which prosecution of the '566 patent is discussed.
- April 7, 2005 Declaration of Thomas L. Cantor (with the attached Exhibit A, Facsimile from Dr. Gao to Dr. Kao on September 21, 1998 and the attached Invoice Form) (Document No. 85 in the present Form PTO/SB/08a/b) in connection with U.S. Patent Application No. 10/617,489. In the declaration, a shipment of three PTH (1-84) Specific IRMA Kits on September 21, 1998 from Dr. Ping Gao, a named inventor of the '566 patent, to Dr. Pai C. Kao of the Mayo Clinic is disclosed.

- Deposition of Thomas Cantor, taken on August 27, 2003 (Document No. 51 in the present Form PTO/SB/08a/b) in which Mr. Cantor answered questions about the use of PTH (1-9) peptide (*See e.g.*, Document No. 51 at pages 78-80.)
- Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 76 in the present Form PTO/SB/08a/b) may contain information potentially relevant to the Declaration of Thomas L. Cantor (Document No. 85 in the present Form PTO/SB/08a/b).
- At page 00245, lines 12-13 of the Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 76 in the present Form PTO/SB/08a/b), the sales figure of "Immutopics BioActive PTH ELISA assays" is redacted.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.

- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000624.

Dated: December 14, 2007

Respectfully submitted,

By 
Peng Chen

Registration No.: 43,543
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 720-5117



ALTERNATIVE TO PTO/SB/08A/B (04/07)

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Complete If Known			
		Application Number	10/760,091		
		Filing Date	January 16, 2004		
		First Named Inventor	Thomas L. CANTOR		
		Art Unit	1641		
		Examiner Name	C. Cheu		
Sheet	1	of	4	Attorney Docket Number	532212000624

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER			
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	1.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Leave to File Amended Complaint, filed January 26, 2004	
	2.	Nichols Institute Diagnostics, Inc.'s Notice of Lodgement of Corrected Copy of Proposed Second Amended Complaint, Exhibit A to Declaration of Julia A. Miller in Support of Nichols' January 26, 2004 Motion for Leave to File Amended Complaint, filed February 23, 2004	
	3.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Summary Judgment that the '790 Patent Claims are Valid and Infringed, filed February 28, 2005	
	4.	Declaration of M. Andrew Woodmansee in Support of Motion for Summary Judgment Pursuant to 35 U.S.C. § 102(b) by Defendants Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc., filed February 25, 2003	
	5.	Declaration of Brigham A. Fordham in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed July 16, 2003	
	6.	Declaration of Peter R. Munson in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 18, 2003	
	7.	Declaration of M. Andrew Woodmansee in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 24, 2003	
	8.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion to Permit Service of its Supplemental Amended Complaint Under F.R.C.P. 15(d), filed November 24, 2003	
	9.	Declaration of Katherine L. Parker in Support of Scantibodies' Reply to Nichols' Opposition to Motion for Judgment on the Pleadings and for Attorneys' Fees, filed February 23, 2004	
	10.	Supplemental Expert Report of Larry W. Evans Pursuant to Rule 26(A)(2)(B), Fed. R. Civ. P.	
	11.	Supplemental Expert Report of L. J. Deftos, MD, JD, LLM	
	12.	Expert Report of Joseph O. Falkinham, III, Ph.D. Adopting Supplemental Expert Report of L. J. Deftos, MD, JD, LLM	
	13.	Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D.	
	14.	Rebuttal Expert Report of Ellen S. Vitetta, Ph.D.	
	15.	Order Granting Scantibodies' Ex Parte Application for Leave to File Documents Under Seal, filed May 4, 2005	
	16.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Confidential Consolidated Declaration of April Alex in Support of Nichols' Opposition to Scantibodies' In Limine Motion Nos. 2 and 5 Under Seal, filed May 5, 2005	
	17.	Declaration of April Alex in Support of Nichols' Ex Parte Application for Order Sealing Its Confidential Consolidated Declaration of April Alex in Support of Nichols' Opposition to Scantibodies' In Limine Motion Nos. 2 and 5 Under Seal, filed May 5, 2005	

Examiner Signature	Date Considered
sd-384191	

Substitute for form 1449/PTO			Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)			Application Number	10/760,091
			Filing Date	January 16, 2004
			First Named Inventor	Thomas L. CANTOR
			Art Unit	1641
			Examiner Name	C. Cheu
			Attorney Docket Number	532212000624
Sheet	2	of	4	

	18.	Confidential Consolidated Declaration of April Alex in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' In Limine Motion Nos. 2 and 5, filed May 5, 2005	
	19.	Scantibodies' Ex Parte Application For Leave to File Documents Under Seal With Oppositions to Nichols' Motions In Limine, Filed May 5, 2005	
	20.	Declaration of Katherine L. Parker in Support of Scantibodies' Ex Parte Application For Leave to File Documents Under Seal, filed May 5, 2005	
	21.	Declaration of M. Andrew Woodmansee in Support of Scantibodies' Oppositions to Nichols' Motions In Limine, filed May 5, 2005	
	22.	Supplemental Exhibits to Joint Trial Brief [Volume 1 of 5], filed May 4, 2005	
	23.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
	24.	Declaration of April M. Alex in Support of Nichols' Ex Parte Application for Order to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
	25.	[Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
	26.	Deposition of Claude Arnaud, Exhibit No. 12	
	27.	Deposition of Thomas Cantor, Exhibit No. 13	
	28.	Deposition of Thomas Cantor, Exhibit No. 14	
	29.	Deposition of Damon Cook, Exhibit No. 16	
	30.	Deposition of Wolf-Georg Forssmann, Exhibit No. 17	
	31.	Deposition of Ping Gao, Exhibit No. 19	
	32.	Deposition of Thomas Godemeyer, Exhibit No. 22	
	33.	Deposition of Markus Magerlein, Exhibit No. 25	
	34.	Deposition of Markus Magerlein, Exhibit No. 26	
	35.	Deposition of Michael Nordstrom, Exhibit No. 28	
	36.	Deposition of K. Ramakrishnan, Exhibit No. 29	
	37.	Deposition of K. Ramakrishnan, Exhibit No. 30	
	38.	Deposition of Randall Ringold, Exhibit No. 31	
	39.	Deposition of Stephen Scheibel, Exhibit No. 32	
	40.	Deposition of Janet Sharp, Exhibit No. 33	
	41.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File the Declaration of James V. Fazio, III in Support of Nichols Institute Diagnostics, Inc.'s Motion In Limine No. 10 to Preclude Counsel From Objecting to Rule 30(B)(6) Designations Under Seal, filed May 4, 2004	
	42.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits A, B, C, D, F, G, H, and J to the Consolidated Declaration of April Alex in Support of Nichols Institute Diagnostics, Inc.'s In Limine Motions Nos. 15-17 Under Seal, filed May 4, 2005	
	43.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits B and C of the Consolidated Declaration of Jane K. Babin in Support of Nichols Institute Diagnostics, Inc.'s In Limine Motions Nos. 19-20 Under Seal, filed May 4, 2005	
	44.	Memorandum of Points and Authorities in Support of Scantibodies' Motion for Summary Judgment of Invalidity and Noninfringement, filed February 18, 2005	

Examiner Signature	Date Considered
sd-384191	

Substitute for form 1449/PTO		Complete if Known			
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Application Number	10/760,091		
		Filing Date	January 16, 2004		
		First Named Inventor	Thomas L. CANTOR		
		Art Unit	1641		
		Examiner Name	C. Cheu		
Sheet	3	of	4	Attorney Docket Number	532212000624

45.	Declaration of Katherine L. Parker in Support of Scantibodies' Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-39, filed February 18, 2005	
46.	Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, filed March 7, 2005	
47.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, with Exhibits A-E, filed March 7, 2005	
48.	Declaration of Katherine L. Parker in Support of Scantibodies' Reply Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-4, filed March 14, 2005	
49.	Deposition of Claude D. Arnaud, taken on February 1, 2005	
50.	Deposition of Gerald Bjorge, taken on January 27, 2005	
51.	Deposition of Thomas Cantor, taken on August 27, 2003	
52.	Deposition of Thomas Cantor (30(B)(6)), taken on September 11, 2003	
53.	Deposition of Damon Cook, taken on June 16, 2003	
54.	Deposition of Damon Cook (30(B)(6)), taken on September 12, 2003	
55.	Deposition of Joseph O. Falkinham, taken on January 21, 2005	
56.	Deposition of Wolf-Georg Forssmann, Ph.D., taken on August 25, 2003	
57.	Deposition of Ping Gao, M.D., taken on June 18, 2003	
58.	Deposition of Allen Garrett, taken on May 20, 2005	
59.	Deposition of Thomas Godemeyer, taken on October 6, 2004	
60.	Deposition of Mark Gray, taken on June 16, 2003	
61.	Deposition of Dr. Richard Lerner, taken on January 13, 2005	
62.	Deposition of Dr. Richard Lerner, taken on March 16, 2005	
63.	Deposition of Markus Magerlein, Ph.D., taken on May 28, 2003	
64.	Deposition of Markus Magerlein, Ph.D., taken on August 10, 2004	
65.	Deposition of Michael Nordstrom (30(B)(6)), taken on September 17, 2003	
66.	Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on August 13, 2003	
67.	Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on September 3, 2003	
68.	Deposition of Stephen Scheibel, taken August 8, 2003	
69.	Deposition of Janet Sharp, taken on August 19, 2003	
70.	Deposition of Randolph Wall, taken January 31, 2005	
71.	Deposition of J. Stuart Woodhead, taken January 18, 2005	
72.	Deposition of Zan Yang, Ph.D., taken on June 16, 2003	
73.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006	
74.	Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages, filed January 27, 2006	
75.	[Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute	

Examiner Signature	Date Considered
sd- 384191	

Substitute for form 1449/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Application Number	10/760,091
		Filing Date	January 16, 2004
		First Named Inventor	Thomas L. CANTOR
		Art Unit	1641
		Examiner Name	C. Cheu
Sheet 4 of 4	Attorney Docket Number	532212000624	

	Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006, order signed Judge Brewster on January 31, 2006	
76.	Confidential Deposition of Tom Cantor, taken on July 11, 2005	
77.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007	
78.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007	
79.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007	
80.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007	
81.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007	
82.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007	
83.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Non-Infringement of the '566 Patent, filed November 13, 2007	
84.	Declaration of Jeffrey Lavigne in Support of Defendants' and Counterclaimants' Motion for Summary Judgment Based on Non-Infringement of the '566 Patent, filed November 13, 2007	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS – PROPRIETARY INFORMATION			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	²
	85.	Declaration of Thomas L. Cantor with Exhibit A, executed on April 7, 2005	

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	Date Considered
sd-384191	

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill Nos. Box #1 - EM 057522185 US, Box #2 - EM 057522199 US, Box #3 - EM 057522208 US, Box #4 - EM 057522211 US, on the date shown below in four boxes addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Filed: December 14, 2007

Signature: Amade
(Anthony Matson)

Patent

Docket No. 532212000624

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

**PETITION TO EXPUNGE INFORMATION
UNDER 37 C.F.R. § 1.59 (b)**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby petition the Commissioner to have the 85 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on December 14, 2007 expunged upon allowance or abandonment of this application.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-84 listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER**. Document numbers 1-75 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), appealed at the United States Court of Appeals for the Federal Circuit as case numbers 06-1087 and 06-1443. Document numbers 76-84 are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx). All of these documents have not otherwise been made public.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document number 85 listed on the attached Form PTO/SB/08a/b because it is **PROPRIETARY** material and has not otherwise been made public.

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-84 on the attached Form PTO/SB/08a/b) and **PROPRIETARY** (document number 85 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned upon mailing of a Notice of Allowance or Abandonment of this application.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

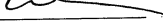
Pursuant to MPEP § 725.05 (E), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to Deposit Account No. 03-1952 referencing docket no. 532212000624. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including

extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000624.

Dated: December 14, 2007

Respectfully submitted,

By 
Peng Chen
Registration No.: 43,543
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858)720-5117



12-17-07

DAC/

TOW
#PTO/SB/21 (12-07)
Approved for use through 12/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/760,091	
	Filing Date	January 16, 2004	
	First Named Inventor	Thomas L. CANTOR	
	Art Unit	1641	
	Examiner Name	C. Cheu	
Total Number of Pages in This Submission	20	Attorney Docket Number	532212000624

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form (1 page + duplicate) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement - Supplemental (4 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition - Petition to Expunge Information (3 pages) <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Petition Fee Transmittal (1 page + duplicate) Form PTO/SB/08A/B (4 pages + duplicate) 85 References Return Receipt Postcard
Remarks Customer No. 25225		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	December 14, 2007	Reg. No.	43,543

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, AirMail Nos. Box #1 - EM 057522185 US, Box #2 - EM 057522199 US, Box #3 - EM 057522208 US, Box #4 - EM 057522211 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 14, 2007

Signature:

(Anthony Matson)



PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10760,091
Filing Date	January 16, 2004
First Named Inventor	Thomas L. CANTOR
Art Unit	1641
Examiner Name	C. Cheu
Attorney Docket Number	532212000624

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.
This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/171.

Payment of Fees (small entity amounts are NOT available for the petition fees).

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments
Enclose a duplicative copy of this form for fee processing.
☐ Check in the amount of \$ _____ is enclosed.
☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.36(a) – for revocation of a power of attorney by fewer than all applicants
- § 1.53(a) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.182 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.69 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.650(c) – for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 – for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.313 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

Signature

Peng Chen

Typed or printed name

December 14, 2007

Date

43,543

Registration No., if applicable

12/18/2007 ATRINH 8888027 031952 10760091
01 FC:1463 200.00 DA



PTO/SB/17 (10-07)
Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/03/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4918).

FEE TRANSMITTAL

For FY 2008

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 180.00

Complete if Known

Application Number	10/760,091
Filing Date	January 16, 2004
First Named Inventor	Thomas L. CANTOR
Examiner Name	C. Cheu
Art Unit	1641
Attorney Docket No.	532212000624

METHOD OF PAYMENT (check all that apply)

☐ Check
 ☐ Credit Card
 ☐ Money Order
 ☐ None
 ☐ Other (please identify): _____

☒ Deposit Account
 Deposit Account Number: 03-1952
 Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below
 ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
 ☐ Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

Total Claims Extra Claims Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims
Fee (\$) Fee Paid (\$)

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
100	100	1		

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement 180.00

SUBMITTED BY		Registration No.	43,543	Telephone	(858) 720-5117
Signature		(Attorney/Agent)		Date	December 14, 2007
Name (Print/Type)	Peng Chen				



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DEC 26 2007

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of :
Thomas L. Cantor et al :
Serial No.: 10/760,091 : PETITION DECISION
Filed: January 16, 2004 :
Attorney Docket No.: 532212000624 :

This is in response to the petition under 37 CFR 1.59(b), filed December 14, 2007, to expunge a Proprietary Information Disclosure Statement from the above identified application.

Petitioner requests that documents submitted with the petition as a Proprietary Information Disclosure Statement (PIDS) be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information submitted as proprietary material was submitted in accordance with M.P.E.P. 724. This application is currently under Final Office action. The material has not yet been considered by the examiner, but will be prior to the next Office action. Upon determination of patentability as evidenced by a Notice of Allowability or abandonment of the application the material will be returned upon submission of a renewed petition. No additional petition fee will be due for the renewed petition.

The petition is **DISMISSED** with prejudice to submission of a renewed petition at an appropriate time.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at general Office facsimile number.



John LeGuyader
Director, Technology Center 1600